



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/306,761	05/07/1999	JACK DENEGER	12177/47501	3926

23838 7590 04/07/2004
KENYON & KENYON
1500 K STREET, N.W., SUITE 700
WASHINGTON, DC 20005

EXAMINER

LE, LANA N

ART UNIT PAPER NUMBER

2685

DATE MAILED: 04/07/2004

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/306,761

Applicant(s)

DENEGER ET AL.

Examiner

Lana Le

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-13 and 16-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-31 is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 01/22/04 have been fully considered but they are not persuasive.

Applicant's arguments of claims 1, 6, 11 and 12 regarding technical capability is not specific in the claimed language as to what the "technical capability" is. Technical capability can be the ability of the mobile phone to acquire any type of service by requesting via the network and then having the ability to receive and display the requested service, such as call forwarding, caller id, web browser services, etc. The argument with regards to the capability to operate on multiple networks is not claimed in the independent claims 1, 6 11 and 12 and the argument toward the cited reference, Hartmaier (US 6,304,753) is irrelevant. Applicant alleges that the network doesn't receive a device identifier, however, the ESN/MIN pair is similar to the claimed device identifier in which the MSC sends the requested services based on the ESN/MIN pair. Therefore the cited reference still reads on those claimed limitations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

Art Unit: 2685

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1, 6, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hartmaier (US 6,304,753).

Regarding claim 1, Hartmaier discloses a method (col 3, line 65 – col 4, line 59) for registering a mobile communication device to a service comprising:

receiving a device identifier (ESN) for the mobile communication device via a communication network, wherein the device identifier is correlated with information concerning what services the mobile communication device has a technical capability to access (col 4, lines 5-19, lines 43-53);

accessing a device capabilities database that includes the information, using the received device identifier (col 2, lines 35-37; col 5, lines 23-30);

receiving, via the network, a request for a service to be provided to the mobile communication device determining, based on the received device identifier and the corresponding information, whether the mobile communication device is capable of receiving the requested service (col 4, lines 13-16); and

when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 4, lines 51-59).

Regarding claim 6, Hartmaier discloses a method (col 3, lines 65-67) for registering a mobile communication device to a service, comprising:

receiving a device attribute for the mobile communication device via a communication network, wherein the device attribute is correlated with information concerning the technical capability of the mobile communication device to receive a requested service (col 4, lines 5-19, lines 43-53);

receiving, via the network, a request for a service to be provided to the mobile communication device; accessing an attribute database that includes the information, using the received device attribute (col 2, lines 35-37; col 5, lines 23-30);

determining, based on the received device attribute and the corresponding information, whether the mobile communication device is capable of receiving the requested service (col 4, lines 13-16); and

when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 4, lines 51-59).

Regarding claim 11, Hartmaier discloses a program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for registering a mobile communication device to a service (col 3, lines 65- col 4, line 19; col 4, line 51 –col 5, line 20), the method comprising:

receiving a device identifier (ESN) for the mobile communication device via a communication network, wherein the device identifier is correlated with information concerning what services the mobile communication device has a technical capability to access (col 4, lines 5-19, lines 43-53);

accessing a device capabilities database that includes the information, using the received device identifier (col 2, lines 35-37; col 5, lines 23-30);

receiving, via the network, a request for a service to be provided to the mobile communication device determining, based on the received device identifier and the corresponding information, whether the mobile communication device is capable of receiving the requested service (col 4, lines 13-16); and

when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 4, lines 51-59).

Regarding claim 12, Sonti et al discloses a program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for registering a mobile communications device to a service (col 3, lines 65- col 4, line 19; col 4, line 51 –col 5, line 20), the method comprising:

receiving a device attribute for the mobile communication device via a communication network, wherein the device attribute is correlated with information concerning the technical capability of the mobile communication device to receive a requested service (col 4, lines 5-19, lines 43-53);

Art Unit: 2685

receiving, via the network, a request for a service to be provided to the mobile communication device; accessing an attribute database that includes the information, using the received device attribute (col 2, lines 35-37; col 5, lines 23-30);

determining, based on the received device attribute and the corresponding information, whether the mobile communication device is capable of receiving the requested service (col 4, lines 13-16); and

when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 4, lines 51-59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartmaier (US 6,304,753) in view of Saunders et al (US 5,918,172).

Regarding claim 3, Hartmaier further discloses the method of claim 1 wherein Hartmaier didn't further disclose the requested service comprises a billing plan for communications using the mobile communication device. Saunders et al further

discloses the method of claim 1 wherein the requested service comprises a billing plan for communications using the mobile communication device (col 4, lines 18-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a billing plan to Hartmaier in order to charge the mobile user for the type or amount of service requested.

3. Claims 4, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartmaier (US 6,304,753) in view of Fehnel (WO 97/34438).

Regarding claim 4, Hartmaier discloses the method of claim 1 wherein Hartmaier didn't further disclose the device capabilities database stores information about whether the mobile communication device is a multi-network phone and the mobile communication device is determined to be capable of receiving the service when the device capabilities database indicates that the mobile communications device is a multi-network phone. Fehnel further discloses the method of claim 1 wherein the device capabilities database stores information about whether the mobile communication device is a multi-network phone and the mobile communication device is determined to be capable of receiving the service when the device capabilities database indicates that the mobile communications device is a multi-network phone (page 19, line 19 – page 20, line 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store information along with the ESN field of Hartmaier about the whether the phone is a multi-network phone in order to verify if the mobile device is able to access the particular feature of service based on the equipment detail.

Regarding claim 7, Hartmaier further discloses the method of claim 6 wherein Hartmaier further discloses said device attribute comprises an electronic serial number (ESN) associated with the device (col 4, lines 20-25); Hartmaier didn't further disclose said attribute database including an indication of whether a device having a particular ESN is a multi-network phone; and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the device is a multi-network phone. Fehnel further discloses said device attribute comprises an electronic serial number (ESN) associated with the device, said attribute database including an indication of whether a device having a particular ESN is a multi-network phone; and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the device is a multi-network phone (page 19, line 19 – page 20, line 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to store information along with the ESN field of Hartmaier about the whether the phone is a multi-network phone in order to verify if the mobile device is able to get the particular feature in the list of services based on the equipment's detail.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartmaier (US 6,304,753) in view of Fehnel (WO 97/34438) as applied to claim 4 above and further in view of Saunders et al (US 5,918,172).

Regarding claim 5, Hartmaier and Fehnel didn't further disclose the method of claim 4 wherein the requested service comprises a billing plan for communications using the mobile communication device. Saunders et al further discloses the method of

claim 1 wherein the requested service comprises a billing plan for communications using the mobile communication device (col 4, lines 18-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a billing plan to Hartmaier and Fehnel in order to charge the user based on the finding out of whether the electronic serial number field supports the digital/analog able phone's services.

5. Claims 8, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartmaier et al (US 6,304,753) in view of Sonti et al (US 6,108,540)

Regarding claim 8, Hartmaier further discloses the method of claim 6 wherein, Hartmaier didn't specifically disclose said device attribute includes a home location identifier to be associated with the mobile communication device;

said attribute database including an indication of which home location identifiers correspond to geographic areas in which the service is receivable; and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the home location of the mobile communication device corresponds to a geographic area in which the service is receivable.

Sonti et al further discloses:

said device attribute includes a home location identifier (LOC field) to be associated with the mobile communication device;

said attribute database including an indication of which home location identifiers correspond to geographic areas in which the service is receivable (col 5, lines 4-55); and the mobile communication device is permitted access to the requested service if

Art Unit: 2685

there is an indication in the attribute database that the home location of the mobile communication device corresponds to a geographic area in which the service is receivable (col 7, lines 14-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an home location identifier in the user profile record of Hartmaier in order to have an extra criteria in the user profile record and to determine which mobile devices is within the service area of the particular requested service from the mobile user.

Regarding claim 10, Hartmaier discloses a method for ascertaining whether to register a mobile communication device to a given service (col 3, lines 65-67; col 4, lines 51-56), the method comprising:

applying a device identifier to an equipment capabilities filter (col 4, lines 20-50); the equipment capabilities filter comprising information concerning what services the device has a technical capability to access (col 4, lines 20-53).

Hartmaier didn't further disclose:

applying a home location identifier to a geographic eligibility filter; and registering the mobile communication device to the given service if the device identifier and home location identifier pass through the equipment capabilities filter and geographic eligibility filter, respectively.

Sonti et al further discloses:

applying a home location identifier to a geographic eligibility filter (location field; col 5, lines 31-36; col 6, lines 65-67); and registering the mobile communication device to the given service if the device identifier and home location identifier (loc field 310)

pass through the equipment capabilities filter and geographic eligibility filter, respectively (col 7, lines 11-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a home location identifier in the user profile record of Hartmaier in order to have an extra criteria in the user profile record and to determine which mobile devices is within the service area of the particular requested service from the mobile user.

Regarding claim 13, Hartmaier discloses a program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for ascertaining whether to register a mobile communication device to a given service (col 3, lines 65- col 4, line 19; col 4, line 51 –col 5, line 20);

the method comprising:

applying a device identifier (ESN field 308) to an equipment capabilities filter, the equipment capabilities filter comprising information concerning what services the device has a technical capability to access (col 4, lines 20-53).

Hartmaier didn't further disclose:

applying a home location identifier to a geographic eligibility filter; and registering the mobile communication device to the given service if the device identifier and home location identifier pass through the equipment capabilities filter and geographic eligibility filter, respectively.

Sonti et al further discloses:

applying a home location identifier (Loc field) to a geographic eligibility filter (col 5, lines 31-37); and registering the mobile communication device to the given service if

the device identifier and home location identifier pass through the equipment capabilities filter and geographic eligibility filter, respectively (col 7, lines 14-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an home location identifier in the user profile record of Hartmaier in order to have an extra criteria in the user profile record and to determine which mobile devices is within the service area of the particular requested service from the mobile user.

Allowable Subject Matter

6. The following is an examiner's statement of reasons for allowance:
7. Claims 16-22 are allowable over the cited prior art due to the objected claim 2 in the previous office action made independent.

Regarding independent claim 16, Hartmaier discloses a method (col 3, lines 65-67) for registering a mobile communication device to a service comprising:

receiving a device identifier (ESN) for the mobile communication device via a communication network, wherein the device identifier is correlated with information concerning what services the mobile communication device has a technical capability to access (col 4, lines 5-53);

accessing a device capabilities database that includes the information, using the received device identifier (col 2, lines 35-37; col 5, lines 23-30);

receiving, via the network, a request for a service to be provided to the mobile communication device determining, based on the received device identifier and the corresponding information, whether the mobile communication device is capable of receiving the requested service (col 4, lines 13-16); and

when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 4, lines 51-59).

However, the cited prior art fails to further disclose:

when it is determined that the communication device is not capable of receiving the requested service, proposing an alternative service to the party that requested service wherein the alternative service is compatible with the mobile communication device.

Regarding independent claim 20, Hartmaier discloses a method for registering a mobile communication device to a service, comprising:

receiving a device attribute for the mobile communication device via a communication network, wherein the device attribute is correlated with information concerning the technical capability of the mobile communication device to receive a requested service (col 4, lines 43-53);

receiving, via the network, a request for a service to be provided to the mobile communication device; accessing an attribute database that includes the information, using the received device attribute (col 2, lines 35-37; col 5, lines 23-30);

determining, based on the received device attribute and the corresponding information, whether the mobile communication device is capable of receiving the requested service (col 4, lines 13-16); and

when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 4, lines 51-59).

However, the cited prior art fails to further disclose:

and when it is determined that the communication device is not capable of receiving the requested service, proposing an alternative service to the party that requested service, wherein the alternative service is compatible with the mobile communication device.

8. Claims 23-31 are allowable over the cited prior art.

Regarding claim 23, Hartmaier (US 6,304,753) discloses a method for registering a subscriber as a receiver for wireless services from a wireless services provider (col 4, lines 65-67), comprising:

(ii) determining whether a wireless communication device associated with the subscriber has a technical capability to be used in a way that the special service is appropriate for the subscriber (col 4, lines 5-53).

(i) Saunders et al discloses receiving a request for the special billing rate from the subscriber (col 4, lines 18-24).

Frager et al further discloses:

Art Unit: 2685

(iii) determining whether the subscriber is eligible for receiving the special billing rate, based at least in part on whether a home location of the subscriber is within a footprint of the wireless services provider (col 2, lines 46 –col 3, line 22).

However, the cited prior art fails to further disclose:

(iv) if a result of the determinations of both (ii) and (iii) is in the affirmative, registering the subscriber as a receiver of the special billing rate, where the special billing rate is such that all calls either made by or received by the subscriber are billed at the same rate whether or not the wireless communication device is within the wireless services provider's footprint or outside the wireless services provider's footprint.

Regarding claim 27, Hartmaier (US 6,304,753) discloses a system for registering a subscriber as a receiver for wireless services from a wireless services provider (col 4, lines 65-67), comprising:

a device capabilities database storing information concerning the technical capabilities of a wireless communication device associated with a subscriber (col 3, lines 21-29);

(i) receive a request for a special service from the subscriber (col 4, lines 5-53);

(ii) access the device capabilities database to determine whether the wireless communication device associated with the subscriber has a technical capability to be used in a way that the special service is appropriate for the subscriber (col 4, lines 43-53).

(i) Saunders et al discloses receiving a request for the special billing rate from the subscriber (col 4, lines 18-24).

Frager et al (US 6,018,652) further discloses:

(iii) access the eligibility database to determine whether the subscriber is eligible for receiving the special billing rate, based at least in part on whether a home location of the subscriber is within a footprint of the wireless services provider (col 2, lines 46 –col 3, line 22).

However, the cited prior art fails to further disclose:

a computer processor coupled to the device capabilities database and the eligibility database, and configured to execute software to:

(iv) if the result of the determinations of both (ii) and (iii) is in the affirmative, registering the subscriber as a receiver of the special billing rate, where the special billing rate is such that all calls either made by or received by the subscriber are billed at the same rate whether or not the wireless communication device is within the wireless services provider's footprint or outside the wireless services provider's footprint.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lana Le whose telephone number is (703) 308-5836. The examiner can normally be reached on M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (703) 305-4385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



Lana Le

March 29, 2004


EDWARD F. URBAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2300